



**PATENT**  
Attorney Docket No. 501609  
Client Reference No.

*AFH*  
*FW*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

James C. Manning

Art Unit: 3729

Application No. 09/996,295

Examiner: Rick Kiltae Chang

Filed: November 28, 2001

For: WIRE INSTALLATION TOOL

**TRANSMITTAL OF  
APPELLANT'S APPEAL BRIEF**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR 41.37, appellant hereby submits Appellant's Brief on Appeal.

The items checked below are appropriate:

**1. Status of Appellant**

This application is on behalf of ☐ other than a small entity or ☒ a small entity.

**2. Fee for Filing Brief on Appeal**

Pursuant to 37 CFR 41.20(2), the fee for filing the Brief on Appeal is for: ☐ other than a small entity or ☒ a small entity.

**Brief Fee Due** \$250.00

**3. Oral Hearing**

☐ Appellant requests an oral hearing in accordance with 37 CFR 41.47.

A separate paper requesting oral hearing is attached.

**4. Extension of Time**

☐ Appellant petitions for a one-month extension of time under 37 CFR 1.136, the fee for which is \$ 0.00.

- ☐ Appellant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that appellant has inadvertently overlooked the need for a petition and fee for extension of time.

**Extension fee due with this request: \$**

**5. Total Fee Due**

The total fee due is:

Brief on Appeal Fee	\$250.00
Request for Oral Hearing	\$ 0.00
Extension Fee (if any)	\$ 0.00

**Total Fee Due: \$250.00**

**6. Fee Payment**

- ☒ Charge Account No. 12-1216 the sum of \$250.00. A duplicate of this transmittal is attached.

**7. Fee Deficiency.**

- ☒ If any additional fee is required in connection with this communication, charge Account No. 12-1216. A duplicate copy of this transmittal is attached.

Respectfully submitted,



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Date: February 9, 2006

CERTIFICATE OF MAILING

I hereby certify that this APPEAL BRIEF TRANSMITTAL AND APPEAL BRIEF (along with any documents referred to as attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Appeal Brief – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Date: Feb. 9, 2006

Nancy Kloster



PATENT  
Attorney Docket No. 501609

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**APPELLANTS' APPEAL BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In support of the appeal from the final rejection dated May 6, 2005, Appellant now submits his Appeal Brief.

**Real Party In Interest**

The Real Party in Interest in this Appeal is the Inventor, James C. Manning.

**Related Appeals and Interferences**

There are no related Appeals, Interferences or Judicial Proceedings.

**Status of Claims**

The Application subject to this proceeding includes claims 1-31. Claims 1-10 are cancelled. Claims 11-12 and 18-23 stand withdrawn by the Examiner. Claims 13-17 and 24-31 are pending in this Application, and stand rejected. Appellant appeals the rejections of claims 13-17 and 24-31, which are reproduced in the attached Claims Appendix.

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**Status of Amendments**

No Amendments have been filed subsequent to the final rejection in the Office Action dated May 6, 2005.

**Summary of Claimed Subject Matter**

In compliance with the rules relating to proper form of an Appeal Brief, all references below relating to the present Application are to the specification and drawings of the present Application, and pertain to paragraph, page numbers and the line numbers of the paragraph (not the line number on the page). For ease of readability, only one reference to the drawings and to the specification by page, paragraph and line number is generally made for each claim term or phrase. Each subsequent reference to a claim term typically includes only the reference character for ready reference. There is no intent to limit the claims in any manner by providing the required references to page, paragraph line, or the drawings, as these references are provided herein solely to comply with the rules relating to proper form of this Appeal Brief.

By way of introduction, all claims subject to this appeal are directed to an embodiment of Applicant's invention, conforming generally to the embodiment depicted in FIGS. 1 and 2, in the form of an electrician's tool (10), comprising a plate (20), structured for attachment to routing components for electrical wiring, such as junction boxes and outlet boxes, an aperture (25) in the plate (20) defines an inner edge (28) of the aperture (25). Two or more rollers (51, 52, 53, 54) are rotatably positioned adjacent the inner edge (28) of the aperture (25) in the plate (20) for precluding contact of a wire passing through the aperture (25) with any portion of the inner edge (28) of the aperture (25).

Applicant's invention is primarily directed to protecting wires being fed through junction boxes and outlet boxes and into conduits in a wiring system for a building, from being cut, chafed, or otherwise damaged by being inadvertently drawn over rough edges of the junction and outlet boxes, as the wire is being installed into the wiring system. (§ 0004, lines 1-2)

During building construction and/or renovation of buildings, a system of electrical conduits, connected together by junction boxes, and terminating at various types of connection or outlet boxes, is typically installed first, and then wiring is fed through the

system of conduit and boxes at a later step in construction. Typically, installation of the wires into the electrical circuit is accomplished by feeding a long, relatively rigid metal tape, commonly known as a fish tape, through the conduits to guide the wire through the electrical circuit during installation. First, the fish tape is pushed through the appropriate conduit or conduits, typically into a junction or outlet box. Next, building wire is connected to the end of the fish tape, typically by attaching the wire around a loop formed in the fish tape and then taping the wire to the loop in the fish tape. Third, the fish tape is reeled in, pulling the wire through the selected path. While the wire is being pulled through the junction boxes, outlet boxes and conduits, it has previously been a standard wiring practice to have one person reeling in the fish tape, at one end of the conduit, and a second person feeding the wire into the junction box at the opposite end of the conduit, with the second person being needed to feed the wire through the junction box in a manner which ensures that the wire, and more specifically the insulation layer protecting the wire, is not damaged on sharp edges and corners of the type often found on junction boxes and other routing members. *Id.*

Utilization of Applicant's tool (10), in the manner taught by the invention, precludes the need for having two persons involved in the rather straight-forward job of feeding wiring through the electrical circuit. For example, through use of Applicant's invention, an electrician may feed a fish tape from into one end of a conduit run, and out through an outlet box at the other end of that conduit run. That same electrician can then attach the wires to the loop at the end of the fish tape, in the customary manner at the other end of the conduit run, and return to the first end of the conduit and pull the wires safely through the outlet box and into the conduit, with the rollers adjacent the inner edge (28) of the aperture (25) in the plate (20) of Applicant's tool (10), when properly attached to the outlet box through which the wires are being fed, precluding contact of the wires being pulled through the box and into the conduit with any portion of the inner edge (28) of the aperture (25), or sharp corners which would be otherwise exposed on the outlet box if the Applicant's tool (10) were not being used. In this manner, the need for two electricians to pull wires through a single conduit run is obviated, providing significant advantages in the form of better utilization of personnel, and potentially reduced costs for installing wires into a conduit system of a building.

**Claim 1, the only independent claim being appealed herein, requires, [a]n electrician's tool (10 in FIGS. 1 and 2; ¶0025) for wiring a building using common routing components (such as electrical junction boxes and outlet boxes (not shown) page 1; ¶ 0004, line 3), the tool comprising:**

**a plate (20 in FIGS. 1 and 2) structured for attachment (i.e. having notches 31-34 in FIG. 1; to receive a threaded fastener (not shown) therethrough, page 4, ¶ 0020, lines 5-7) to routing components (such as junction boxes and outlet boxes (not shown), page 1; ¶ 0004; line 3);**

**the plate (20) having an aperture (25 in FIG. 1) formed therein, the aperture (25) defining an inner edge (28 in FIGS. 1 and 2) of the aperture (25); and**

**two or more rollers (51, 52, 53, 54 in FIG. 1; with, only 53 showing in cross-section in FIG. 2) rotatably positioned (on axles 55, 56, 57, 58 in FIG. 1; with only axle 57 showing in cross-section in FIG. 2) adjacent the inner edge (28) for precluding contact of a wire (not shown) passing through the aperture (25) with any portion of the inner edge (28) of the aperture (25).**

**Claim 17, depending from claim 13 via claim 16 requires that, the tool (10) of claim 13, include at least one roller (51, 52, 53, 54) having a diameter greater than a thickness of the plate (20), and that the at least one roller (51, 52, 53, 54) is positioned to extend both above and below a plane defined by the plate (20) (see, FIG. 2), such that wire may be passed through the aperture (25) from either direction.**

It is contemplated, that in embodiments of the invention, the rollers might be shaped differently, in a manner allowing fewer than the four rollers depicted in Applicant's exemplary embodiment of FIG. 1 to be used in totally protecting a wire from contacting and portion of the edge of the aperture. For triangular shaped apertures, for example, only three rollers might be used.

**Grounds of Rejection to be Reviewed on Appeal**

1. Claims 13-15 and 24-27 stand rejected under 35 USC § 102 as being anticipated by U.S. Patent No. 6,349,460 to Eslambolchi, et. al, (hereinafter "Eslambolchi").

2. Claims 16-17 and 28-31 stand rejected under 35 USC § 103(a) as being obvious over U.S. Patent No. 6,349,460 to Eslambolchi, et. al, ("Eslambolchi") in view of U.S. Patent No. 5,271,605 to Damron (Damron).

**Argument**

All of the Examiner's rejections of the pending claims, as being anticipated or rendered obvious over the prior art, are based upon a misconstrued and unsupportable interpretation of Eslambolchi, in combination an improper disregarding of the majority of the limitations of independent claim 13, from which all other claims being considered in this Appeal depend.

The Examiner also committed reversible procedural error, by not withdrawing finality of the Office Action from which this Appeal is taken, to allow the Applicant to respond as a matter of right to new grounds for rejection raised for the first time by the Examiner in an Advisory Action mailed in reply to Applicant's Response to Final Office Action and Request for Reconsideration (without amendment of any claim), in which the Applicant pointed out that the Examiner had failed to provide any basis for considering only some of the limitations of Applicant's claims in rejecting of those claims, as being anticipated by Eslambolchi, or obvious over the Eslambolchi in view of Damron.

**A. Claims 13-15 and 24-27 are not anticipated by Eslambolchi.**

Eslambolchi was cited by the Examiner for the first time in the Final Office Action, in reply to the Applicant's Arguments and amendment of the claims (3/02/2005) in response to the preceding Office Action (12/02/2004). As support for rejecting claims 13-15 and 24-27, the Examiner provided only the following statement, at page 2 of the Final Office Action:

2. *Claims 13-15 and 24-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Eslambolchi et al (US 6,349,460).*

*Eslambolchi discloses 38 with a plate having an aperture with four rollers.*

In reply to the Applicant's Response (filed 7/06/2005) to the Final Office Action of March 2, 2005, in which the Applicant argued that the Examiner had improperly disregarded the majority of the limitations of Applicant's claims, the Examiner issued an Advisory



Action, dated July 21, 2005, maintaining finality and providing the following additional justification for rejection:

*Fig. 1 clearly shows rollers are rotatably positioned adjacent to the inner edge of the aperture. "for...aperture" is nothing more than functional language.*

Applicant then filed the Notice of Appeal, and a Petition for Pre-Appeal Review, which resulted in this Appeal.

**(1) Claims must be examined in their entirety, including all limitations of all elements.**

Per long established practice under the "All Elements Rule."

**(2) The "for...aperture" limitations, disregarded by the Examiner, precisely describes salient structural attributes and relationships between inter-related elements which are critical to operation of the Applicant's claimed invention, and must, therefore, be considered in examination of Applicant's claims.**

The functional language which the Examiner has ignored, "must be evaluated and considered just like any other limitation of the claim for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." *MPEP § 2173.05(g)*. The language ignored by the Examiner, although functional, constitutes a perfectly acceptable claim limitation, "because it sets definite boundaries on the patent protection sought" by the Applicant, (*MPEP § 2173.05(g)*, citing *In re Barr*(CCPA 1971)), and "serve[s] to precisely define present structural attributes of inter-related component parts of the claimed assembly, (*MPEP § 2173.05(g)*, citing *In re Venezia* 189 USPQ 149(CCPA 1976)).

Specifically, the functional limitation **"for precluding contact of a wire passing through the aperture (25) with any portion of the inner edge (28) of the aperture (25)**, ignored by the Examiner, precisely defines structural attributes of the rollers (51-54) and aperture (25), of Applicant's invention, in a manner requiring that the rollers (51-54) and aperture (25) be configured and oriented with respect to one another within definite structural boundaries, so that the rollers (51-54) perform in a manner which is critical to operation of

the Applicant's invention, i.e. precluding contact of a wire or cable passing through the aperture (25) of Applicant's device with any portion of the inner edge (28) of the aperture (25), to thereby prevent any portion of the edge (28) of the aperture (25) from causing damage to the wire or cable as it is pulled through the aperture (25).

The claim limitations which the Examiner has chosen to ignore, clearly help to distinguish the Applicant's invention over the prior art cited by the Examiner, as discussed in more detail in the following sections.

- (3) **Contrary to the Examiner's assertion, FIG. 1 of Eslambolchi does not clearly show Applicant's claimed structure, and cannot, therefore serve to anticipate Applicant's claims.**

(a) **Comments relating to Applicant's assumptions, given lack of clarity as to Examiner's interpretation of Eslambolchi**

As a necessary preliminary step in comparing the disclosure and drawing FIG.1 of Eslambochi to the limitations of Applicant's claims, so that this Appeal may move forward, it is necessary for the Applicant to make some assumptions regarding what features the Examiner was referring to in his statements in support of his rejection, given that Eslambolchi does not clearly lay out the structure, or relationships between structures, alluded to by the Examiner, compounded by the Examiner's not providing concise references to Eslambolchi, or sketches showing his assumptions relating to what he believes to be shown in FIG. 1 of Eslambolchi.

For example, in neither the Final Office Action, nor the Advisory Action, does the Examiner provide any indication or explanation as to what part of the pushing mechanism 38 (*FIG. 1; Col. 2, Ln. 62*) of Eslambolchi, that the examiner considers to be "a plate having an aperture with four rollers."

Applicant's assumptions below are not to be construed as admissions relating to the disclosure, teachings or suggestions, of Eslambolchi, but rather just the Applicant's best guess as to how the Examiner's interpreted Eslambolchi, and what Eslambolchi can reasonably be said to disclose, teach or suggest with regard to having any relevance to examination of the pending claims of Applicant's invention.

That the Applicant has to make such assumptions is instructive, however, to illustrate the lack of clarity of Eslambolchi with regard to various reasonable interpretations of what it

would teach or suggest to one skilled in the art, other than the interpretation apparently taken by the Examiner, and the inadequateness of FIG. 1 of Eslambolchi in reaching the required standard for use as prior art in supporting a rejection of Applicant's claims.

**(b) General inadequacy of FIG. 1 of Eslambolchi as a basis for rejection.**

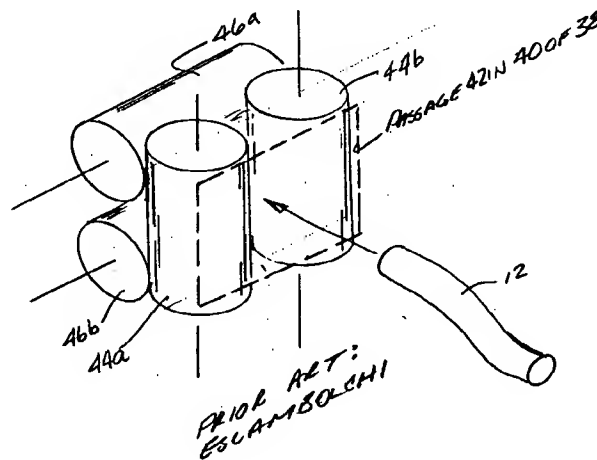
As a matter of housekeeping, it is noted that FIG. 1 of Eslambolchi is substantially a partially exploded perspective drawing, including a main view of a generally pictorial nature, showing the pushing mechanism 38 referenced by the Examiner only as a non-exploded assembly, with the main view hereinafter being referred to as FIG. 1p. FIG. 1 also includes a non-pictorial schematic view of selected elements of the pushing mechanism 38, which will hereinafter be referred to as FIG. 1s of Eslambolchi.

Drawings and pictures can only be said to anticipate claims if they clearly show the structure which is claimed. *MPEP* § 2125, citing *In Re Mraz*, 173 U.S.P.Q. 25 (CCPA 1972). However, the drawing or picture must show all the claimed structural features, and how they are put together. *MPEP* § 2125, citing *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928). Where a reference does not disclose that the drawings are to scale, and is silent as to dimensions, arguments based on measurement of drawing features are of little value. *MPEP* § 2125. It is well established that patent drawings do not define the precise proportions of the elements, and may not be relied on to show particular sizes if the specification is completely silent on the issue. However, the description of an article picture can be relied on, in combination with the drawings, for what they would reasonably teach one of ordinary skill in the art. *Id.*

The description of Eslambolchi does not disclose that the drawings are to scale, and provides very limited information regarding dimensional and spacial relationships between the various elements of Eslambolchi included in the Examiner's apparent interpretation of the teachings of Eslambolchi.

**(4) Eslambolchi does not disclose all limitations of Independent claim 13 of Applicant's claimed invention, and cannot, therefore anticipate claim 13 or any of claims 14-15 and 24-27 depending therefrom.**

Applicant submits that the sketch below depicts the following reasonable interpretation of the description and drawings of Eslambolchi to be most in keeping with the Applicant's understanding of the Examiner's position, assuming that the Examiner equated: the unlabeled end surface, of the pushing mechanism 38, as shown in Eslambolchi FIG. 1p, and squarish-looking opening therein, through which it is indicated that the casing 18 of Eslambolchi would enter, to constitute a plate and aperture, according to Applicant's claim 13, with the opening being assumed to be the central passage 42 through the housing 40 of the pushing mechanism 38 (See *eslambolchi*, col., 2 ln. 61 – col. 3 ln 48); and the two unlabeled cylindrical shaped objects located within the body 40 of the pushing mechanism 30 to constitute rollers, according to Applicant's claim 13, and as further constituting the pair of motor driven rollers 44a, 44b lying on opposite sides of the passage 42 of Eslambolchi, *Id*.



Applicant provided the forgoing depiction in the Response (7/06/2005 ) to the Final Office Action (5/06/2005). Applicant notes that Eslambolchi FIG. 1s, was essentially useless in preparing the depiction above, due to the schematic nature of FIG. 1s. Eslambolchi FIG. 1s, taken in conjunction with the written description of Eslambolchi (See *eslambolchi*, col., 2 ln. 61 – col. 3 ln 48) does indicate, however, that the central passage 42 of Eslambolchi probably does not refer to the squarish-shaped opening in the end of the pushing mechanism 38, as indicated in the depiction above, but the depiction was prepared with the assumption that the Examiner had perhaps equated the opening in the end surface of the pushing mechanism with the central passage 42 through the housing 40 of the pushing mechanism of

Eslambolchi. It appears that a correct interpretation of the central passage 42 would be more along the lines of an axially oriented passageway, extending through the length of the pushing mechanism, along which the pairs of rollers 44a, 44b, and 46a, 46b are located at some unspecified axial distance from the end of the pushing mechanism 38, and attached to the housing 40.

The foregoing depiction represents the Applicant's understanding, based upon a careful reading of the text of Eslambolchi et al., and examination of the figures thereof, that all of the rollers 44a, 44b, 46a, 46b, are positioned inside of the housing 40 and behind the passage 42, with the vertical rollers 44a, 44b being closest to the passage 42, and the horizontal rollers 46a, 46b being displaced behind the vertical rollers 44a, 44b, so that both the vertically oriented set of rollers 44a, 44b and the horizontally oriented rollers 46a, 46b can be moved outward to allow insertion of the casing 18, as taught at column 3, lines 36-37, and thereafter be moved inward to bear against the periphery of the optical fiber cable 12, as taught at lines 37-39 of column 3. Eslambolchi is silent as to the function of the unlabelled end surface of the pushing mechanism 38, and as to any attachment or other operative connection or functional relationship between the end surface and the rollers.

As clearly illustrated in the depiction above, and as shown in FIG. 1p of Eslambolchi, the rollers 44a, 44b, 46a, 46b of Eslambolchi et al. cannot preclude the cable 12 from coming into contact with the top and/or bottom edges of the passage 42.

Because such contact with the top and bottom edges can occur, Eslambolchi et al., does not teach or suggest the required limitation of all pending claims in the application that contact with any portion of the inner edge of an aperture, in a tool according to the invention, be precluded.

The Applicant also specifically notes that Eslambolchi et al., nowhere teaches or suggests that the rollers 44a, 44b, 46a, 46b have the capability of meeting the requirement of claim 13 of the present invention, that "two or more rollers be rotatably positioned adjacent to the inner edge of the aperture for precluding contact of a wire passing through the aperture with any portion of the inner edge of the aperture." It is further noted, that in FIG. 1p of Eslambolchi et al., it appears that only the two vertical edges of the passage 42 in the housing 40 of the pushing mechanism 38 might be said to be protected by the vertical rollers 44a, 44b, in a manner which might preclude contact between the fiber optic cable 12 and the vertical edges of the passage 42. It appears, however, from FIG. 1p of Eslambolchi et al., that the rollers 44a, 44b, 46a, 46b of Eslambolchi et al. provide no protection against the fiber optic cable 12 coming into contact with the top and bottom edges of the passage 42.

In general, therefore, it appears to the Applicant, that the Examiner has misunderstood and/or misconstrued the teachings of Eslambolchi et al. with regards to the positioning of the

rollers 44a, 44b, 46a, 46b in relation to the passage 42. From FIG. 1p of Eslambolchi et al., and the text of the disclosure of Eslambolchi et al., from column 2, line 61, through column 3, line 39, and in particular column 3, lines 4-11 and 33-39, it appears that the four rollers 44a, 44b, 46a, 46b cannot lie in the same plane with one another, and still be capable of closing in to "bear against the periphery of the optical fiber cable 12," as taught by Eslambolchi et al. at lines 38 and 39 of column 3. It further appears, that a reasonably correct arrangement of the rollers 44a, 44b, 46a, 46b, partially illustrated in FIG. 1p of Eslambolchi et al., and consistent with the written disclosure of Eslambolchi et al. is as shown in the Applicant's depiction above.

When properly interpreted, Applicant submits that Eslambolchi does not disclose, all of the limitations of Applicant's claim 13, and cannot, therefore anticipate claim 13, or any of claims 14-15, and 24-27 depending therefrom.

**B. Claims 16-17 and 28-31, are not obvious over Eslambolchi et al. (US 6,349,460), in view of Damron (US 5,271,605).**

The following quotations from MPEP § 2143 form the primary basis for traversing all rejections in the Office Action, under 35 U.S.C. § 103(a):

**2143 Basic Requirements of a *Prima Facie* Case of Obviousness**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

**2143.01 Suggestion or Motivation To Modify the References [R-1]**

**THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION**

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the

suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

**FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS**

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

**(1) No motivation for combining Eslambolchi and Damron**

Applicant first notes that the Examiner has not cited any evidence of motivation within the cited references or the level of knowledge of those skilled in the art to which the invention pertains, for combining the teachings of Eslambolchi et al. and Damron. The Applicant specifically notes that these two references appear to come from different classifications, with Eslambolchi et al., being directed to installation of fiber optic cables in underground conduits, and Damron being directed to installation of electrical wires in conduit and wiring boxes in the walls of a building. Only Damron appears to be closely analogous art to the present invention, and it is correctly cited only as a secondary reference.

**(2) The Examiner has provided no justification for making the combination of Eslambolchi and Damron, and has arrived at the combination by impermissible hindsight reconstruction.**

In meeting the requirement for citing evidence of motivation for combining references, the Examiner cannot rely solely on conclusory statements, as presented in paragraph 4 of the Office Action. Conclusory statements cannot be relied on when dealing with particular combinations of prior art and specific claims. The rationale for combining references must be put forth. *In re Lee*, 61 U.S.P.Q. 2d 1430, 1433. The Examiner can

satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that the knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references."

Only by impermissibly working backward from the Applicant's disclosure can the Examiner allege any grounds for asserting the combination of Eslambolchi et al. and Damron. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)(The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

**(3) Eslambolchi does not teach or suggest the claim limitations asserted by the Examiner, in the combination of Eslambolchi and Damron, and therefore, the combination of Eslambolchi and Damron does not render obvious any of Applicant's claims 16-17 and 28-31.**

Claims 16-17 and 28-31, all depend from claim 13. As stated above, in relation to Appeal of the rejection under 35 USC § 102, the Examiner has not, and indeed cannot, provide a proper basis for rejecting claim 13 or any other of the pending claims over Eslambolchi et al. standing alone, because Eslambolchi et al., standing alone, fails to teach or suggest all of the claim limitations required by claim 13 and claims 14-17 and 24-31 depending from claim 13.

With specific regard to Claim 17, contrary to the Examiner's assertions at paragraph 4 of the Office Action, Applicant also specifically notes that Eslambolchi et al. does not anywhere disclose, teach or suggest that the rollers 44a, 44b, 46a, 46b extend both above and below a plate, as required by claim 17 of the present application. The element 40 of Eslambolchi is a block-shaped housing, not a plate, and there is no teaching or suggestion in FIG. 1p, FIG. 1s, or anywhere else in Eslambolchi that teaches or suggests that any of the rollers 44a, 44b, 46a, 46b of Eslambolchi extend both inside and outside of the housing 40.

Having the tool (10) include a substantially flat plate (20) with rollers (51-54) extending above and below the plate (20), as shown in Applicant's FIG. 2, allows the tool (10) to be installed with either side of the plate (20) bearing against the junction box to



which the plate (20) is attached, thereby providing for ease of use. (¶0027, lines 1-6). Neither Eslambolchi nor Damron discloses, teaches or suggests such reversibility of their respective devices.

The Examiner correctly, in paragraph 4 of the Office Action, does not assert that Damron standing alone teaches or suggests all of the claimed limitations of claims 16-17 or 28-31, and further correctly does not assert that Damron is cited as teaching or suggesting any of the limitations of Applicant's claims other than those listed in paragraph 4 of the Final Office Action, and reproduced below:

*4. Claims 16-17 and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eslambochi et al (US 6,349,460) in view of Damron (US 5,271,605).*

*Eslambolchi discloses rollers positioned to extend above and below and 40 is square, except for at least one roller has a diameter greater than a thickness of the plate; a rectangular aperture; and angled mounting slots located adjacent to the four corners.*

*Damron discloses roller 18 has a diameter greater than a thickness of the plate 10 in Fig. 2; a rectangular aperture in Fig. 1; and angled mounting slots located adjacent to the four corners (36).*

*It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Eslambolchi by at least one roller has a diameter greater than a thickness of the plate, as taught by Damron, for the purpose of routing the wire without touching the plate; providing more rooms for the wires to pass through; and quickly mounting or removing to and from a junction box.*

Given that Damron does not teach the limitations of Applicant's claims, for which the Examiner erroneously relied upon Eslambolchi, the combination of Eslambolchi et al. and Damron also does not teach or suggest all of claim 13, and therefore fails to meet the *prima facie* requirements for a case of obviousness for claim 13 or any of claims 16-17 or 28-31 depending from claim 13. *MPEP § 2143. MPEP 2143.03, citing In re Fine, 837 F.2d 1071 (Fed. Cir 1988)(if an independent claim is non obvious under 35 USC 103, then any claim depending therefrom is non-obvious).*

**C. The Examiner committed reversible error by not withdrawing finality of the Office Action of May 6, 2005, when he cited new grounds for rejection for the first time in the Advisory Action of July 21, 2005**

As discussed in greater detail above, with regard to proper examination of Applicant's claims in the section relating to Appeal of the Anticipation rejections, the Examiner's rejection of the claim limitation referenced in Sections A(1) and A(2) above as being "nothing more than functional language" constituted new grounds for rejection, not previously presented by the Examiner, and not resulting from an Amendment by the Applicant, which should have occasioned withdrawal of the finality of the Office Action dated May 6, 2005, so that the Applicant could respond to these new grounds of rejection as a manner of right.

Applicant's Response to Final Office Action and Request for Reconsideration did not include any amendment to the claims under consideration and subject to the Final Office Action of May 6, 2005. It appears that upon reviewing the Applicant's traversal of all rejections in the Final Office Action, as stated in Applicant's Response to the Final Office and Request for Reconsideration, the Examiner decided to, for the first time, raise the new grounds for rejection discussed in section 'A' above.

***Conclusion***

For the foregoing reasons, Applicant respectfully requests that each of the rejections advanced in the Final Office Action dated May 6, 2005 be reversed and withdrawn and that the Application move forward toward issuance.

Respectfully submitted,



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Date: February 9, 2006

*Claims Appendix*

13. An electrician's tool for wiring a building using common routing components, the tool comprising:

a plate structured for attachment to routing components;

the plate having an aperture formed therein, the aperture defining an inner edge of the aperture; and

two or more rollers rotatably positioned adjacent the inner edge for precluding contact of a wire passing through the aperture with any portion of the inner edge of the aperture.

14. The tool of claim 13, wherein the aperture is rectangular shaped defined by the inner edge having four sides, and wherein at least four rollers are rotatably positioned adjacent the inner edge, with at least one roller for each side of the inner edge, for precluding contact of the wire with any of the four sides of the inner edge of the aperture.

15. The tool of claim 14, wherein the rollers include ends, the ends of the rollers being positioned proximate each other to form a substantially continuous surface for safely sliding wire across the rollers and through the aperture.

16. The tool of claim 13, wherein the at least one roller has a diameter greater than a thickness of the plate.

17. The tool of claim 16, wherein the at least one roller is positioned to extend both above and below a plane defined by the plate, such that wire may be passed through the aperture from either direction.

24. The tool of claim 13, wherein at least two of the two or more rollers are oriented substantially perpendicular to one another.

25. The tool of claim 13, wherein the aperture defines orthogonally intersecting longitudinal and lateral axes thereof, and the rollers are positioned to simultaneously preclude contact between any portion of the inner edge and one or more wires passing through the aperture in either direction along either of the longitudinal and lateral axes.

26. The tool of claim 25, wherein the rollers are rotatable about roller axes, at least one of which is oriented parallel to either the longitudinal or the lateral axis of the aperture.

27. The tool of claim 26, wherein the roller axis of each of the rollers is oriented parallel to either the longitudinal or the lateral axis of the aperture.

28. The tool of claim 13, wherein the aperture is rectangular.

29. The tool of claim 13, wherein the plate is generally square and includes mounting holes spaced to correspond to standard mounting holes in routing components.

30. The tool of claim 29, wherein the mounting holes include slots positioned adjacent the four corners.

31. The tool of claim 30, wherein at least one of the slots is angled relative to an outer edge of the plate.

In re Appln. of James C. Manning  
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**Evidence Appendix**

None.

In re Appln. of James C. Manning  
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**Related Proceedings Appendix**

None.